REMARKS

Claims 1, 3-6, 8-11, 13-17 and 19-23 are pending in this application.

Claims 1 and 6 are being amended to include "in a manner omitting randomness" and "the test e-mail messages lacking a primary purpose of commercial advertising or promotion of a commercial product or service".

Claims 15 and 22 are being amended to include "in a manner omitting randomness".

No new matter is added.

A. Rejection under 35 U.S.C. § 101

Claims 1-11 [*sic*], 13-17 and 19-23 stand rejected under 35 U.S.C. § 101 because the claimed invention is purportedly directed to non-statutory subject matter. According to the Examiner, the present invention is non-statutory subject matter because it is in violation of CAN-SPAM Act of 2003 where the "claims are directed to an invention that sends unsolicited email to addresses it extrapolates from not readily available personal information that is extracted from websites via software agents." (*See* paragraph 16, page 5 of the Office Action.)

Applicants respectfully disagree with the Examiner that the invention recited in claims 1, 3-6, 8-11, 13-17 and 19-23 violates the CAN-SPAM Act of 2003 (herein after "CAN-SPAM Act"). In the previous Amendments filed on July 5, 2006 and September 16, 2005, Applicants submitted that a test e-mail recited in the claims does not constitute a SPAM that violates CAN-SPAM Act because a test-e-mail message does not advertise nor promote a commercial product or service. Furthermore, it was Applicants' position that the claims met the requirements of 35 U.S.C. § 101 because the invention is useful for extracting public data about people from the Web and for organizing the data into a database for organizational information. (*See* page 7, lines 18-23 of the Specification.) In asserting this position, Applicants reminded the Examiner that "[s]tatements made by the applicant in the specification or incident to prosecution of the application before the Office cannot, standing alone, be the basis for a lack of utility rejection under 35 U.S.C. § 101." (*See* MPEP § 2107.02I, 2100-28, right column, Original 8th Ed., August 2001, Latest Rev. Aug. 2006.) While Applicants believe the reasons in the previously filed

Amendments are sufficient to overcome the rejection under 35 U.S.C. § 101, further reasons are submitted below to persuade the Examiner.

(1) Policing SPAM under the CAN-SPAM Act Is Not in the Purview of the USPTO

As addressed above, the Examiner maintained that the claimed device is non-statutory subject matter because it is in violation of the CAN-SPAM Act. However, it is not in the purview of the USPTO to enforce the CAN-SPAM Act and to determine whether an invention violates the CAN-SPAM Act. As the Examiner admitted in the Office Action (*see* paragraph 16, page 5, the Office Action), Congress authorized the Federal Trade Commission (FTC) to enforce CAN-SPAM Act, as well as the Department of Justice, not the USPTO or the Department of Commerce. In its authorization to enforce under CAN-SPAM Act, the FTC provides the rulemaking requirements, hearing procedures, and adjudicatory standards and procedures under the CAN-SPAM Act. Accordingly, it is the FTC that determines whether an activity constitutes a SPAM under the CAN-SPAM Act and that imposes a penalty, not the USPTO. Therefore, the USPTO lacks authority to apply and make interpretation under the CAN-SPAM Act to Applicants' invention. Without such authoritative interpretation, there is lack of support of the § 101 rejections of claims 1, 3-6, 8-11, 13-17 and 19-23 under the CAN-SPAM Act.

A rejection under 35 U.S.C. § 101 for lack of utility should not be based on grounds that the invention is frivolous, fraudulent or against public policy. (*See* MPEP, § 706.03(a), 700-70, right column, Original 8th Ed., August 2001, Latest Rev. Aug. 2006.) Even if a use of an invention may be adverse to public policy, the purported adverse use cannot be a reason for rejecting the claims for lack of utility. Congress "*never* intended that the patent laws should displace the police powers of the States, meaning by that term those powers by which the health, good order, peace and general welfare of the community are promoted." *See* Juicy Whip Inc. v. Orange Bang Inc., 185 F.3d 1364, 1367-68, 51 USPQ2d 1700, 1702-03 (Fed. Cir. 1999) (italics added). As such, identifying the present invention as non-statutory subject matter (not meeting the § 101 requirement) and rejecting the claims based on purported violation of the CAN-SPAM Act are indeed an inappropriate enforcement of the CAN-SPAM Act and an exercise of the police power with which USPTO is not granted. There are more than sufficient grounds that the

claimed test e-mail sent by the present invention is not a "commercial electronic mail" under the CAN-SPAM Act as explained in the section A.(2) of this Amendment.

Furthermore, the Examiner is reminded that the invention has complied with for the utility requirement of § 101 if at any time during the examination and if it becomes readily apparent that the claimed invention has well-established utility. (*See* MPEP, § 2107 (II), 2100-20, left column, Original 8th Ed., August 2001, Latest Rev. Aug. 2006.) As previous stated, claims 1, 3-6, 8-11, 13-17 and 19-23 meet the requirements of 35 U.S.C. § 101 because the invention is useful for extracting publicly available data about people from the Web and for organizing the data into a database for organizational information.

(2) The Present Invention Does Not Violate the CAN-SPAM Act of 2003

The Examiner stated that the CAN-SPAM Act covers "emails whose primary purpose is advertising or promoting a commercial product or service, including on a Web site." (*See* paragraph 16 on page 5, Office Action, quoting the definition of "commercial electronic mail message" in 15 U.S.C. 103, § 7702(2)(A).) Furthermore, the Examiner stated that claims 1-11 [sic], 13-17 and 19-23 refer to business e-mail addresses and testing said business addresses. (*See* paragraph 16, page 5 of the Office Action.) According to the Examiner, the device of the present invention "can be embodied as a device to search for information on individuals and send them non-solicited pornography and marketing electronic messages." (*See* paragraph 16, page 5 of the Office Action.)

The § 7702(2)(A) that the Examiner recited and relied on for the basis of rejection under 35 U.S. C. § 101 is directed to the definitions of the terms used in the CAN-SPAM Act, delineating the metes and bounds of the terms so that interpretation and application of CAN-SPAM Act would not be improperly construed and depart from the spirit of the statute. Apart from the definitions of the terms, however, the § 7702(2)(A) does not provide the rule of law for determining whether an act is in violation of the CAN-SPAM Act. Instead, one needs to look to 15 U.S.C. 103, § 7703(a) (hereinafter "§ 7703(a)") under the heading and subheading of "PROHIBITION AGAINST PREDATORY AND ABUSIVE COMMERCIAL E-MAIL, Fraud and related activity in connection with electronic mail" for such rule of law. The § 7703(a) states the following:

(1) accesses a protected computer without authorization, and intentionally initiates the transmission of multiple commercial electronic mail messages from or through such computer,

(2) uses a protected computer to relay or retransmit multiple commercial electronic mail messages, with the intent to deceive or mislead recipients, or any Internet access service, as to the origin of such messages,

(3) materially falsifies header information in multiple commercial electronic mail messages and intentionally initiates the transmission of such messages,

(4) registers, using information that materially falsifies the identity of the actual registrant, for five or more electronic mail accounts or online user accounts or two or more domain names, and intentionally initiates the transmission of multiple commercial electronic mail messages from any combination of such accounts or domain names, or

(5) falsely represents oneself to be the registrant or the legitimate successor in interest to the registrant of 5 or more Internet Protocol addresses, and intentionally initiates the transmission of multiple commercial electronic mail messages from such addresses,

or conspires to do so, shall be punished as provided in subsection (b). (Emphasis added.)

The present invention as recited in claims 1, 3-6, 8-11, 13-17 and 19-23, however, does not violate any subsection under the § 7703(a) for the following reasons contrary to the Examiner's assertion (each enumerated paragraph below includes remarks corresponding to each of the above enumerated parts of the § 7703(a)):

1) The present invention *does not* access "a protected computer." Instead, as recited in base claims 1, 6, 11 and 17, the present invention extracts data from "publicly available information" or "a global computer network". Furthermore, the present invention *does not* initiate the transmission of multiple electronic messages *from or through* such computer. Rather, a test e-mail message is sent to the interpolated/generated e-mail addresses from processor 51/invention system after the extraction of data, instead of from or through the protected computer. (*See* page 26, lines 19-27 of Specification.)

2) Again, the present invention *does not* access or use "a protected computer" in any capacity to violate the part (a)(2). Furthermore, the test e-mail is not sent by the present invention to the interpolated/generated e-mail addresses *with the intention to deceive or mislead recipients*, or any Internet access service, as to the origin of such messages but for verification purposes. The Examiner is reminded that the test e-mail has no content or a heading to deceive or mislead recipients.

3) The present specification does not disclose or teach that the test e-mails are sent under *materially falsified header information in multiple commercial electronic mail messages* or *intentionally initiates* the transmission of such messages. An e-mail that the CAN-SPAM Act intended to inhibit is "unsolicited commercial electronic mail purposefully includ[ing] misleading information in the messages' subject lines in order to induce the recipients to view the messages." (*See* 15 U.S.C. 103, § 7701(a)(8).) In contrast, the test e-mails to the interpolated/generated e-mail addresses by the present invention are sent for verification purposes as stated earlier. Therefore, these test e-mails are not sent under *materially falsified header information* because the purpose of sending the e-mail in the present invention is not to induce the recipients to view the messages but to determine whether the interpolated/generated e-mail addresses are indeed working addresses.

4) The present invention does not register, using information that *materially falsifies the identity of the actual registrant*, any e-mail account or online user account.

5) The present invention does not *falsely represent oneself to be the registrant or the legitimate successor* in interest to the registrant of any Internet Protocol address.

Accordingly, the test e-mails sent by the present invention do not constitute a SPAM as defined under the CAN-SPAM Act.

Furthermore, Applicants do not agree with the Examiner's interpretation of 15 U.S.C. 101, § 7703(b)(i) (hereinafter "§ 7703(b)(i)"). In support of the rejection, the Examiner referred to several portions of the § 7703(b)(i), which purportedly spells out a method of improperly

obtaining electronic mail messages. (*See* paragraph 8 of page 4, Office Action.) The full subsection is as follows:

> (1) Directive - Pursuant to its authority under section 994 (p) of title 28 and in accordance with this section, the United States Sentencing Commission shall review and, as appropriate, amend the sentencing guidelines and policy statements to provide appropriate penalties for violations of section 1037 of title 18, as added by this section, and other offenses that may be facilitated by the sending of large quantities of unsolicited electronic mail.
> (2) Requirement - In carrying out this subsection, the Sentencing Commission shall consider providing sentencing enhancements for—
> (A) those convicted under section 1037 of title 18 who—
> (i) obtained electronic mail addresses through improper means, including—
> (I) harvesting electronic mail addresses of the users of a website, proprietary service, or other online public forum operated by another person, without the authorization of such person; and
> (II) randomly generating electronic mail addresses by computer; or
> (ii) knew that the commercial electronic mail messages involved in the offense contained or advertised an Internet domain for which the registrant of the domain had provided false registration information; and
> (B) those convicted of other offenses, including offenses involving fraud, identity theft, obscenity, child pornography, and the sexual exploitation of children, if such offenses involved the sending of large quantities of electronic mail.
>
> (emphasis added)

The Examiner added that the portions of the § 7703(b)(i), is purportedly analogous to the claim language "automatically generating e-mail address of a subject person ... such that at least one verified constructed potential e-mail address provides a business e-mail address of the subject person." (*See* paragraph 16 on page 5, Office Action.)

Contrary to the Examiner's assertion, the § 7703(b)(i) is irrelevant to the analysis for determining whether the present invention violates the CAN-SPAM Act. As stated in the heading of the § 7703(b)(i), the methods described above provide merely a sentencing guideline if one sends a SPAM defined under the CAN-SPAM Act. That is, if one commits an activity that fall under, for example, the § 7703(a) *and* harvested e-mail addresses using the method prescribed in the § 7703(b)(i), the penalty can be greater for the § 7703(a)-violating activity than

one that did not used the method of the § 7703(b)(i). Therefore, to apply the § 7703(b)(i), there must first be a § 7703(a)-violating activity. When one, however, commits an act covered alone under the § 7703(b)(i), the act cannot be a violation of the CAN-SPAM Act. In such a situation where one does not commit any offence under the § 7703(a) despite collecting e-mail addresses in accordance with the § 7703(b)(i), the § 7703(b)(i) is irrelevant. As addressed earlier, the present invention does not send a SPAM under the CAN-SPAM Act. Therefore, even if the present invention is construed to collect e-mail addresses in accordance with the method described in the § 7703(b)(i), the present invention cannot and does not constitute a SPAM under the CAN-SPAM Act.

For the reasons discussed above, withdrawal of rejection of claims 1, 3-6, 8-11, 13-17 and 19-23 for lack of utility under 35 U.S. C. § 101 is respectfully request. In an abundance of clarity, base claims 1, 6, 15, 22 are now amended to cast the subject matter of the present invention outside of the terms of the cited reference. Such limitations are acceptable according to MPEP § 2173.05(i) and do not add new matter. Acceptance is respectfully requested.

B. Rejections under 35 U.S.C. § 103

On paragraph 14 on page 4 of Office Action, the Examiner stated regarding Applicants' arguments against the Henrick, Miller, Biliris, Knight and Feridun references that one cannot show nonobviousness by attacking reference individually where the rejections are based on combination of references While Applicants agree with the Examiner's statement, the Examiner is reminded that it is also true that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." (*See* MPEP § 2143.03 (VI), 2100-130, left column, Original 8th Ed., August 2001, Latest Rev. Aug. 2006.)

1. Rejections under 35 U.S.C. § 103(a) over Cranor et al.

Claims 1-11 [*sic*], 13-17, and 19-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cranor *et al.* (hereinafter "Cranor"). The Examiner stated that Cranor

disclosed that spamming was performed by harvesting information such as email addresses from the World Wide Web. The Examiner further stated that "Cranor failed to disclose a method of doing this, but disclosed that it was taking place prior to the publication of the article 1998." (*See* paragraph 19 on page 6, Office Action.)

Cranor relates to concerns about the proliferation of unsolicited bulk email that has been steadily increasing. (*See* page 74 of Cranor.) In Cranor, two cases studies on SPAMs are presented and several solutions for dealing with SPAMs are suggested. Regarding the subject matter of generating e-mail addresses from the Web, Cranor states the following:

> But serious bulk mailers invest a few hundred dollars in specialized software capable of sending 250,000 messages with forged headers per hour and *harvesting email addresses from Usenet, the Web, and online services.* After making the initial investment in a personal computer and the software, a bulk mailer can send out hundreds of thousands of messages a day with minimal work and monthly service fees.
>
> (*See* page 76 of Cranor, starting on the left column; emphasis added.)

However, Applicants disagree with the Examiner that the invention recited in claims 1, 3-6, 8-11, 13-17, and 19-23 are obvious in view of Cranor because the Examiner has not established a *prima facie* case of obviousness. According to MPEP, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." (*See* MPEP § 2142, 2100-125, left column, Original 8th Ed., August 2001, Latest Rev. Aug. 2006.) To establish a *prima facie* case of obviousness, three basics must be met by a preponderance of evidence. They are as follow:

> First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.
>
> (*See* MPEP § 2142, 2100-125, right column, Original 8th Ed., August 2001, Latest Rev. Aug. 2006.)

> The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). T
>
> (*See* MPEP § 2142, 2100-126, left column, Original 8th Ed., August 2001, Latest Rev. Aug. 2006.)

However, the Examiner has not met the initial burden. Cranor, the prior art reference, does not teach or suggest all the claim limitations. The relevant section of Cranor recited above does teach that a software can harvest email addresses from the Web, Cranor does not teach or suggest all the steps of claims 1, 3-6, 8-11, 13-17, and 19-23. Namely, Cranor does not teach using digital processor means coupled to a database that automatically: obtains a working e-mail address to the respective organization, the working e-mail address not being the e-mail address of a subject person; deduces from the working e-mail address, format of e-mail addresses to the respective organization; using the deduced information, constructs potential e-mail addresses for the subject person named in the database but for whom e-mail address information is missing, the potential e-mail addresses being with respect to a respective organization named in the database for the subject person; and verifies each potential e-mail address by sending test e-mail messages using the potential e-mail addresses to an e-mail server to determine a response of the e-mail server to the test email messages.

Furthermore, while Applicants acknowledge that *a method* for harvesting email addresses from the Web existed in 1998 as disclosed in Cranor, Applicants do not agree with the Examiner that it would have been obvious to one of ordinary skill in the art to create the present invention that comprises the recited steps or components described in claims 1, 3-6, 8-11, 13-17, and 19-23 in 1998. It is further noted that Cranor merely informs that such a method exists but as the Examiner stated, it does not teach or suggest any steps or components involved in the method. As required in MPEP,

> Office personnel should make express fact-findings relating to the *Graham* factors, focusing primarily on the prior art teachings discussed above. The fact-findings should specifically articulate what teachings or suggestions in the prior art would have motivated one of ordinary skill in the art to select the claimed species or subgenus. *Kulling*, 897 F.2d at 1149, 14 USPQ2d at 1058; *Panduit*

Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1579 n.42, 1 USQP2d 1593, 1606 n.42 (Fed. Cir. 1987).

(*See* MPEP 2144.08, IIA5, 2100-150, left column, Original 8th Ed., August 2001, Latest Rev. Aug. 2006; underlining added.)

Accordingly, Applicants respectfully request the Examiner to provide his reasoning how one skilled in the art would arrive at the recited steps or components of the present invention. Absent such reasoning, the Examiner has not met the initial burden of establishing a *prima facie* case of obviousness.

Because Cranor fails to establish a *prima facie* case of obviousness, Applicants respectfully request that the rejection of claims 1, 3-6, 8-11, 13-17, and 19-23 under 35 U.S.C. 103(a) be withdrawn.

2. *Rejections under 35 U.S.C. § 103(a) over Henrick et al. in view of Miller in view of Biliris et al.*

Claims 1, 3, 6 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,377,936 to Henrick *et al.* (hereinafter "Henrick") in view of Online Search Secrets by Miller (hereinafter "Miller") in view of U.S. Patent Publication No. 2001/0009017 (hereinafter "Biliris").

Henrick is directed to the problem of developing a method for operating a computer network that enables merchandise and service providers to market their products to network users without invading the privacy of the user. (*See* col. 1, lines 32-36, Henrick.) Conversely, Miller is directed to searching for email addresses using an internet service provider. (*See* page 173, Miller.) Lastly, Biliris is directed to a messaging system, and method of operation thereof, which supports combinations of directory and mailing list addressing mechanisms, provides the capability to specify intended message recipients using combinations of mailing list and directory information and does not require mailing lists to be explicitly enumerated. (*See* paragraph 9 on page 1, Biliris.)

Applicants, however, disagree with the Examiner that the combination of the three references renders the present invention obvious. In particular, the Examiner stated that Henrick discloses "providing a database storing information regarding people, the database including for

each person at least name of the person and the name of respective employer for which the person is currently employed...." (*See* paragraph 20 on page 6, Office Action.) Regarding its database, Henrick teaches that it "takes advantage of the unique customer knowledge of an Internet Service Provider (ISP) with respect to both the customers identity and their likes and dislikes, *while preserving the privacy of those customers.*" (*See* col. 3, lines 9-14, Henrick; italics added.) For example, "the customer is informed that they may take advantage of the offer and as a convenience and service to the customer and the advertiser, the ISP will provide their identity to the advertiser." (*See* col. 3, lines 25-29, Henrick.) The database regarding the customers identity and their likes and dislike is not publicly available because "only when the customer selects the embedded URL is their identity disclosed to the advertiser." (*See id.*) Contrary to the database of Henrick, the present invention of base claims 1 and 6 requires providing a database storing publicly available information.

Furthermore, Applicants disagree with the Examiner's statement that while Henrick fails to disclose what to do if email address information is missing from the database, this deficiency is cured by Miller, which "discloses *well know techniques* for finding email address information on the web." (*See* paragraph 21 on page 7, Office Action; italics added.) However, the *well known techniques* taught in Miller do not coincide with that of the present invention in base claims 1 and 6. Under the heading of "Picking an Email Directory," Pages 174 of Miller teaches the following:

> Some of the [Internet service providers] that offer email directory services are quite good, all limitations notes, and are worth checking out if you need to find someone's email address.
> Many of these email directory sites also offer white pages services (discussed in Chapter 14, "Search for Names, Addresses, and Phone Numbers") and yellow pages services (discussed in Chapter 19, "Search for Business"). All let you enter a name or part of a name as your query; some let you enter other information as well, such as phone number, city and state, or company name.

Furthermore, page 175 of Miller provides a table that lists some of the more popular email directory Web sites and their URLs for searching for an email address. Therefore, the *well known technique* that Miller teaches is to use email directory Web site services for finding an email address without teaching, disclosing or suggesting how these email directory Web sites obtain an email address.

Different from using email directory Web site services in Miller, the technique in base claims 1 and 6 includes the step of using digital processor means coupled to the database, *automatically* using the deduced information, constructing potential e-mail addresses for the subject person named in the database. The technique in base claims 1 and 6 also include that for whom e-mail address information is missing from the database, the potential e-mail addresses being with respect to a respective organization named in the database for the subject person of base claims 1 and 6 of the present application. To that end, the specification disclosed that Post-Processor 51 which enhances the data, in particular analyzes the data and adds missing pieces of information, such as email addresses. (*See* Fig. 1 and page 11, lines 28-29, Specification.) The invention recited in base claims 1 and 6 is distinguished from that of Miller because instead of having a person to type the URL of an email directory Web site and to input the information directed to the missing e-mail as in Miller, the missing email addresses are constructed automatically in base claims 1 and 6 with respect to a respective organization named in the database for the subject person.

Lastly, Applicant disagree with the Examiner's statement that it would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Henrick in view of Miller and Biliris, for the purpose of sending messages to recipients without an explicitly enumerate mailing list. (*See* paragraph 24 on page 7, Office Action.) The Examiner supported his conclusion by stating that Henrick gives motivation for the combination of teachings by stating that a user who might be interested in receiving information is reluctant to provide information to business. (*See id.*, referring to col. 1, lines 23-27, Henrick.)

However, rather than motivating for the combination of teachings, Henrick's purpose to identify the customers identity and their likes and dislikes *while preserving the privacy of those customers* teaches away from the present invention. The service provided by Henrick requires that "[t]he consent agreement will be embedded in the message when it is delivered" to a customer. (*See* col. 4, lines 6-9, Henrick.) In contrast, the present invention does not infringe any privacy by sending a test e-mail, and the present invention of base claims 1 and 6 has no need for a consent requirement when sending test e-mail for verification. Therefore, one skilled in the art would not be motivated to combine another prior art with Henrick, which requires a consent to preserve the privacy of customers, to render the present invention obvious.

In view of the foregoing, a *prima facie* obviousness of the present invention recited in base claims 1 and 6 has not been established. Accordingly, Applicants respectfully request the §103(a) rejections of base claims 1 and 6 be withdrawn. Likewise, claims 3 and 8, which depend from claims 1 and 6, would be allowable for the same reasons.

3. Rejections under 35 U.S.C. § 103(a) over Henrick et al. in view of Miller in view of Biliris et al. and in further view of Mills

Claims 4 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Henrick in view of Miller in view of Biliris in further view of Mills (Australian Patent Abstract No. AU-A-53031/98; hereinafter "Mills"). According to the Examiner, it would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Mills with the teachings of Henrick in view of Miller in view of Biliris for the purpose of improving the method of building a searchable database of contact information. (*See* paragraph 31 on page 8, Office Action.)

Claims 4 and 9 depend from base claims 1 and 6, which recites the step regarding using crawler means automatically extracting information regarding people and/or organizations from sites of a global computer network and storing the extracted information in the database, such that the database is formed by automated means. Without discussing the merits of the examiner's reason for rejection, Applicants point out that Mills does not cure this deficiency of teaching-factors by Henrick and Miller to make claims 4 and 9 obvious. Therefore, Applicants respectfully request the § 103(a) rejection of claims 4 and 9 be withdrawn.

4. Rejections under 35 U.S.C. § 103(a) over Henrick et al. in view of Miller in view of Biliris et al. and in further view of Barroux

Claims 5 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Henrick in view of Miller in view of Biliris in further view of U.S. Patent No. 5,923,850 to Barroux (hereinafter "Barroux"). According to the Examiner, it would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Barroux with the teachings of Henrick in view of Miller in view of Biliris for the purpose of

tracking changes over time in information collected by network agents. (*See* paragraph 31 on page 8, Office Action.)

Claims 5 and 10 depend from base claims 1 and 6, which recites the step regarding using crawler means automatically extracting information regarding people and/or organizations from sites of a global computer network and storing the extracted information in the database, such that the database is formed by automated means. Without discussing the merits of the examiner's reason for rejection, Applicants point out that Barroux does not cure this deficiency of teaching-factors by Henrick and Miller to make claims 5 and 10 obvious. Therefore, Applicants respectfully request the § 103(a) rejection of claims 5 and 10 be withdrawn.

5. Rejections under 35 U.S.C. § 103(a) over Knight in view of Barroux

Claims 11, 13, 17, 19, and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6, 493,703 to Knight *et al.* (hereinafter "Knight") in view of U.S. Patent No. 6,336,139 to Feridun *et al.* (hereinafter "Feridun").

As stated earlier, MPEP states that "[t]o establish a prima facie case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, . . . to combine reference teachings." Paragraph 41 of page 8 of Office Action stated that "Knight gives motivation for the combination by stating that not distinguishing between subject areas (changes in a person) results in frustration to the user. (*See* column 9, lines 45-54, Knight.)" This statement is correct insofar as it presents a problem solved by the invention disclosed in Knight. Applicants, however, do not see how this statement provides a suggestion or motivation to combine Knight with Feridun. Knight and Feridun disclose different systems to solve different problems. Knight discloses an electronic message board system that classifies content from discussion boards or newsgroups to substantially eliminate "the need for manual, cumbersome review of individual messages throughout dozens of new groups [sic] with non-illuminating identifiers." (*See* col. 9, lines 48-50, Knight.) Feridun, on the other hand, discloses a method of event correlation to manage events generated by managed computers in a large and complex distributed computer network. One of ordinary skill in the art faced with the problem of resolving two database records of potentially a same person would not look to event correlation as is disclosed in Feridun.

In addition, neither Knight nor Feridun disclose all the elements of base claims 11 and 17. First, neither Knight nor Feridun disclose comparing the name of a person and another separate piece of information indicated in a first record with the name of a person and another separate piece of information indicated in a second record as claimed in base claim 17. Instead, Knight classifies or sorts content from discussion boards or newsgroups and Feridun correlates events generated by distributed computers. Second, neither Knight nor Feridun disclose the further step of merging the first and second records into one record if the name of the person is the same in the two records and the other two separate pieces of information between the two records are reasonably the same as claimed in base claim 17. Instead, Knight classifies or sorts content from discussion boards or newsgroups and Feridun aggregates correlated events.

Since neither Knight, Feridun, nor the knowledge generally available to one of ordinary skill in the art provide any suggestion or motivation to combine the teachings of Knight and Feridun, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) be withdrawn. Furthermore, because Knight and Feridun, alone or in combination, do not teach, suggest, or otherwise make obvious the limitations of base claim 17 ("comparing the name of a person indicated in a first record with the name of a person indicated in a second record; determining whether another two separate pieces of information between the first and second records are reasonably the same if the name comparing results in a match; merging the first and second records into one record when . . . the other two separate pieces of information . . . [are] reasonably the same."), Applicants respectfully request that the rejection of base claim 17 under 35 U.S.C. § 103(a) be withdrawn. Base claim 11 includes similar limitations as base claim 17; therefore, Applicants respectfully request that the rejection of base claim 11 under 35 U.S.C. § 103(a) be withdrawn for at least the same reasons.

Claims 13, 19 and 20 depend from base claims 11 and 17, respectively. As explained above, there is no suggestion or motivation to combine Knight and Feridun and the same references, alone or in combination, do not teach, suggest, or otherwise make obvious the limitations of base claims 11 and 17. Since claims 13 and 19-20 depend from base claims 11 and 17, respectively, Applicants respectfully request that the rejection of Claims 11, 13, 17, 19 and 20 under 35 U.S.C. 103(a) be withdrawn for at least the same reasons.

6. Rejections under 35 U.S.C. § 103(a) over Knight in view of Henrick

Claims 14 and 21 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Knight and Henrick. Henrick does not add to Knight merging the first and second records into one record if the name of the person is the same in the two records and the other two separate pieces of information between the two records are reasonably the same as claimed in base Claims 11 and 17. Without discussing the merits of the Examiner's reasons for rejection, because claims 14 and 21 depend from base claims 11 and 17, respectively, Applicants respectfully request that the rejection of Claims 14 and 21 under 35 U.S.C. 103(a) be withdrawn for at least the same reasons.

7. Rejections under 35 U.S.C. § 103(a) over Knight in view of Henrick in view of Biliris

Claims 15-16 and 22-23 have been rejected under 35 U.S.C. 103(a) being unpatentable over Knight, Henrick, in view of Biliris. Henrick and Biliris do not add to Knight merging the first and second records into one record if the name of the person is the same in the two records and the other two separate pieces of information between the two records are reasonably the same as claimed in base Claims 11 and 17. Without discussing the merits of the Examiner's reasons for rejection, because claims 15-16 and 22-23 depend from base claims 11 and 17, respectively, Applicants respectfully request that the rejection of Claims 15-16 and 22-23 under 35 U.S.C. 103(a) be withdrawn for at least the same reasons.

CONCLUSION

In view of the above amendment and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By _____
H. Joon Chung
Registration No. 52,748
Telephone: (978) 341-0036
Facsimile: (978) 341-0136

Concord, MA 01742-9133
Dated: 12/5/06